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09/783,194	02/14/2001	Andrew J. Hoffman	GWK-001.01	5401

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EXAMINER

ZHOU, TING

ART UNIT	PAPER NUMBER
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2173

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DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/783,194

Applicant(s)

HOFFMAN, ANDREW J.

Examiner

Ting Zhou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 23-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/25/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### **DETAILED ACTION**

1. Claims 1-49 are pending. Claims 23-49 are withdrawn from consideration on the grounds that these claims are directed toward a non-elected invention. Claims 1-22 were confirmed as being the group of claims directed to the invention elected for the present prosecution, with traverse, in the election made over the phone on 11 March 2004.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-22, drawn to assembling an electronic textbook according to user preferences, classified in class 345, subclass 747.
  - II. Claims 23-42, drawn to selecting and editing a textbook from a database, classified in class 707, subclass 3.
  - III. Claims 43-49, drawn to information providing virtual classrooms, classified in class 345, subclass 705.
3. Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as creating an interface for assembling a textbook in accordance with user selected preferences and settings. In the instant case, invention II has separate utility such as querying a database of textbooks to select a textbook to edit. In the instant case, invention III has separate utility such as providing a virtual

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classroom environment capable of delivering textbooks, notes, exams and other information to users. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Kevin Oliver on 11 March 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-49 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Drawings*

6. The drawings are objected to because the following reference characters are not labeled in an appropriate descriptive manner: the reference characters in Figure 1 need reference labels indicating what each of the boxes represents.

7. Applicant is required to submit a proposed drawing correction of the above noted deficiencies in reply to this Office action. However, formal correction of the noted defect may

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be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

***Claim Objections***

8. Claims 4 and 14 are objected to because of the following informalities:

a. In claim 4, the intended meaning of the phrase “providing an interface the layout of the modules” on line 2 of the claim is unclear.

b. In claim 14, the intended meaning of the phrase “at least one database to store the at modules” on line 5 of the claim is unclear; it is suggested that the limitation be changed to -- at least one database to store the at least one module --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7, 9, 11-20, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Munyan U.S. Patent 5,761,485.

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Referring to claim 1, Munyan teaches a method comprising receiving preferences from a user (receiving user selection of icons representing electronically stored material), presenting at least one module to the user based on the preferences (for example, if a magazine is selected, its table of contents is displayed to the user), receiving module selections from the user (user selecting a page to read), and assembling the selected modules into an electronic textbook (displaying the selected pages on the electronic textbook display screen), as recited in column 5, lines 50-58. Furthermore, when users touch icon 3 in Figure 1 for example, a communications link is established to the bookstore and various libraries or modules are presented to the user. Upon selecting one of the presented modules, the selected product or service can be displayed as an electronic book, as recited in column 7, lines 33-67.

Referring to claim 14, Munyan teaches a system comprising at least one user interface (column 12, lines 4-25) to receive preferences from a user (receiving user selection of icons representing electronically stored material and), present at least one module to the user based on the preferences (for example, if a magazine is selected, its table of contents is displayed to the user), and receive module selections from the user (user selecting a page to read), at least one database to store the at least one module (column 6, lines 18-21), and at least one processor to access the database (column 6, lines 12-17), coordinate the operation of the user interface, and assemble the selected modules into an electronic textbook (displaying the selected pages on the electronic textbook display screen), as recited in column 5, lines 50-58. Furthermore, when users touch icon 3 in Figure 1 for example, a communications link is established to the bookstore and various libraries or modules are presented to the user. Upon selecting one of the presented modules, the selected product or service can be displayed as an electronic book, as recited in column 7, lines 33-67.

Referring to claims 2 and 15, Munyan teaches providing an interface to allow the user to edit the assembled modules, as recited in column 9, lines 5-16.

Referring to claims 3 and 16, teaches providing an interface to modify the preferences (selecting another icon), as recited in column 9, lines 30-38.

Referring to claim 4, teaches providing an interface for the layout of the modules (column 12, lines 4-25).

Referring to claims 5 and 18, Munyan teaches printing the electronic book, as recited in column 9, lines 5-12.

Referring to claims 6, Munyan teaches transmitting the electronic textbook to the user (displaying the material to the user), as recited in column 4, lines 63-67 and column 7, lines 59-67.

Referring to claims 7 and 19, Munyan teaches receiving preferences from a user further including receiving at least one data selected from subject matter, location, age level, difficulty level, text length, number of classes, workload per class, text proportion, illustration proportion, teaching style, aspect emphasis, format, assignment, types, location, cost per copy, and total cost (the user selects icons that can be displayed according to subject, the type of product it is, such as dictionary, thesaurus, the type of function it provides, etc.) (column 7, lines 17-29 and column 8, lines 1-20).

Referring to claim 9, Munyan teaches receiving information from the user further including providing an interface having at least one option selection (selecting at least one of the icons presented) (column 7, lines 17-40).

Referring to claim 11, Munyan teaches receiving preferences further comprising receiving preferences over a computer network (column 5, lines 66-67 and column 6, lines 1-17).

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Referring to claim 12, Munyan teaches presenting at least one module to the user based on the preferences including presenting the at least one module over a network (column 5, lines 66-67 and column 6, lines 1-17).

Referring to claim 13, Munyan teaches presenting at least one module to the user based on the preferences further including associating the preferences with descriptors associated to the modules (each user selected icon or preference, has an associated function or material) (column 7, lines 16-29).

Referring to claim 17, Munyan teaches a layout editor (column 7, lines 65-67 and column 8, lines 1-1-5).

Referring to claim 20, Munyan teaches the user interface further including at least one of check boxes, radio buttons, sliders, and text input boxes (buttons such as icons and page numbers used to input bookmarks, and text input boxes such as user input of an identification code and/or password) (column 7, lines 33-40 and column 8, lines 48-55).

Referring to claim 22, Munyan teaches a network connection between the processor and a client (network connection between the processor of the host computer and the on-line bookstore) (column 6, lines 1-17).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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10. Claims 8, 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan U.S. Patent 5,761,485, as applied to claims 1 and 14 above, and further in view of Nichols et al. U.S. Patent 5,987,443.

Referring to claims 8, 10 and 21, while Munyan teaches all of the limitations as applied to the claims above, he fails to explicitly teach receiving information from the user further including providing an interface having at least one question, assembling questions based on the selected modules and a question generator based on the module selections. Nichols et al. teach a knowledge system presenting information in the form of an online textbook (column 11, lines 58-61) similar to that of Munyan. In addition, Nichols et al. further teaches an interface having a module generator producing at least one question and assembling questions based on user selection, or student mistakes (column 33, lines 25-30, column 126, lines 23-30 and column 130, lines 12-16). It would have been obvious to one of ordinary skill in the art, having the teachings of Munyan and Nichols et al. before him at the time the invention was made, to modify the method of Munyan to include the questions taught by Nichols et al. It would have been advantageous for one to utilize such a combination in order to provide a more customized display of the electronic textbook to the user; by presenting questions to the user regarding user preferences, the system can change and modify the look and feel of the display according to user's likings.

11. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider

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these references fully when responding to this action. The documents cited therein teach similar methods of presenting electronic textbooks.

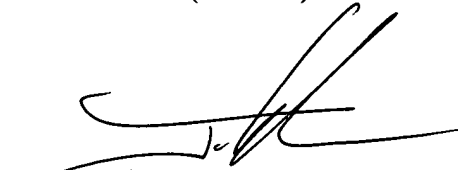
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (703) 305-0328. The examiner can normally be reached on Monday - Friday 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 15, 2004

  
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